

III. Remarks

A. Status of the Application

Claims 26-30 and 33-35 are pending. No claims are presently canceled, added, or amended. Reconsideration of claim 26-30 and 33-35 in light of the following remarks is respectfully requested.

As a preliminary matter, while the Office Action Summary indicates that claim 33 is rejected, there is no rejection of claim 33 set forth in the Office Action. Accordingly, Applicants submit that claim 33 is in condition for allowance.

B. Claim Rejections – Double Patenting

Claims 26-30, 34, and 35 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8, 9, and 25-33 of U.S. Patent No. 6,749,614. A terminal disclaimer is filed herewith. Accordingly, Applicants request that the double patenting rejection of claim 26-30, 34, and 35 be withdrawn. In that regard, as the double patenting rejection is the only rejection of claim 34 set forth in the Office Action, Applicants submit that claim 34 is in condition for allowance.

C. Claim Rejections – 35 U.S.C. §103

Claims 26 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of U.S. Patent No. 5,658,286 to Sava (“the Sava patent”) and U.S. Patent No. 5,397,363 to Gelbard (“the Gelbard patent”).

As the PTO recognizes in MPEP § 2142:

... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a prima facie case of obviousness does not exist for claims 26 and 29 for at least the reasons set forth below.

35 U.S.C. §103(a) provides, in part, that:

“A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time of the

invention was made to a person having ordinary skill in the art . . .”
(emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

With respect to independent claim 26, however, even when combined the Sava and Gelbard patents fail to disclose all of the recited limitations. For example, claim 26 recites “a first support structure, configured to extend through the portals in the first and second bone anchors; a second support structure, configured to be attached to the spine; and a cross bar, which connects the first support structure to the second support structure to form an orthopedic construct; wherein the cross bar is attached to the first and second support structures subcutaneously; and wherein at least the cross bar comprises a media that is hardenable while the support structure is positioned within the body of a patient.” It is clear that the Sava and Gelbard patents do not disclose such limitations.

The Office Action asserts that “Sava also discloses a cross bar (18) that connects a first support structure to a second support structure (see construct in Fig. 2B).” However, it is clear that the tubing 18 of the Sava patent does not meet the recited limitations of the cross bar of claim 26. First, the tubing 18 is filled with a quick-setting molding material to form “a rigid **temporary master** (Fig. 2C) that is **used as a template** to form the element.” Col. 5, ll. 43-67 (emphasis added). Accordingly, the tube 18 does not connect first and second support structures to form an orthopedic construct as required. Instead the tube 18 is simply used as a template for shaping the actual metal spinal support bars that are implanted into the patient. Col. 5, ll. 59-62. Second, the tube 18 does not appear to connect a first support structure configured to extend through portals of two bone anchors to a second support structure, as required. Instead, the tube 18 and the resultant spinal rod created from the template of tube 18 appear to be the only components of the Sava patent that are seated within the u-shaped opening of the pedicle screws 14. Accordingly, the tube 18 does not connect a first support structure configured to extend through portals of two bone anchors to a second support structure, as recited. The Gelbard patent clearly does not disclose a cross bar as recited in claim 26. Accordingly, even when combined the Sava and Gelbard patents fail to disclose all of the recited limitations of independent claim 26.

Thus, for at least these reasons a *prima facie* case of obviousness has not been established with respect to independent claim 26. Claim 29 depends from and further limits claim 26.

Accordingly, Applicants request that the §103 rejection of claims 26 and 29 over the Sava and Gelbard patents be withdrawn.

With respect to dependent claim 29, the Office Action asserts that “Gelbard also discloses what may be considered cross ties (37), as they are also able to help fix a rod into position (Col. 4, lines 37-55).” However, it is clear that the segmented slotted members 37 of the Gelbard patent are not cross ties as recited in claim 29. Claim 29 requires “a first cross tie connecting the cross bar to the first support, and a second cross tie connecting the cross bar the second support.” However, the slotted members 37 are not used in conjunction with the rigid plates 36, which the Examiner is considering the first and second supports. Rather, the slotted member 37 and attachment nuts 46 are used to fix rod 28 in position. Accordingly, even when combined the Sava and Gelbard patents fail to disclose first and second cross ties as recited in claim 29. For at least this additional reason a *prima facie* case of obviousness has not been established with respect to claim 29. Accordingly, Applicants request that the §103 rejection of claim 29 over the Sava and Gelbard patents be withdrawn.

Claims 30 and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Sava and Gelbard patents as applied to claim 26 in further view of U.S. Patent No. 4,743,260 to Burton (“the Burton patent”). Claims 30 and 35 depend from and further limit claim 26. As shown above, a *prima facie* case of obviousness has not been established with respect to claim 26 with the Sava and Gelbard patents. The Burton patent does not affect this deficiency. Accordingly, for at least the same reasons a *prima facie* case of obviousness has not been established with respect to claims 30 and 35. Therefore, Applicants request that the §103 rejection of claims 30 and 35 over the Sava, Gelbard, and Burton patents be withdrawn.

Claims 27 and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Sava and Gelbard patents as applied to claim 26 in further view of U.S. Patent No. 6,336,930 to Stalcup et al. (“the Stalcup patent”). Claims 27 and 28 depend from and further limit claim 26. As shown above, a *prima facie* case of obviousness has not been established with respect to claim 26 with the Sava and Gelbard patents. The Stalcup patent does not affect this deficiency. Accordingly, for at least the same reasons a *prima facie* case of obviousness has not been established with respect to claims 27 and 28. Therefore, Applicants request that the §103 rejection of claims 27 and 28 over the Sava, Gelbard, and Stalcup patents be withdrawn.

IV. Conclusion

It is believed that all matters set forth in the Office Action have been addressed and that all of the pending claims are in condition for allowance. An early indication of allowance is respectfully requested.

Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on February 12, 2008.

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